

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 2-5, 8-30, and 32-36 are currently pending. Claims 8, 17, 23, and 32 are independent and are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §103

Claims 8, 3, 4, 9-13, 17, 19, 23-27, and 33-35 were rejected under 35 U.S.C. §103 as allegedly unpatentable over U.S. Patent No. 7,013,477 to Nakamura et al. (hereinafter, merely “Nakamura”) in view of U.S. Patent No. 6,973,669 to Daniels in view of U.S. Patent No. 5,027,400 to Baji et al. (hereinafter, merely “Baji”) in view of U.S. Patent Application Publication No. 2002/0166120 of Boylan III et al. (hereinafter, merely “Boylan”);

Claims 2 and 18 were rejected under 35 U.S.C. §103 as allegedly unpatentable over Nakamura, Baji, Boylan and further in view of U.S. Patent Application Publication No. 2002/0019769 of Barritz et al. (hereinafter, merely "Barritz");

Claims 5, 14, 20, and 28 were rejected under 35 U.S.C. §103 as allegedly unpatentable over Nakamura, Daniels, Baji, Boylan and further in view of U.S. Patent Application Publication No. 2003/0192060 of Levy;

Claims 15, 16, 21, 22, 29, and 30 were rejected under 35 U.S.C. §103 as allegedly unpatentable over Nakamura, Daniels, Baji, Boylan and further in view of U.S. Patent No. 6,285,818 to Suito et al. (hereinafter, merely "Suito"); and

Claim 32 and 36 rejected under 35 U.S.C. §103 as allegedly unpatentable over Nakamura, Baji, and Boylan.

Applicants respectfully traverse these rejections.

A. Independent Claims 8, 17, 23, and 32

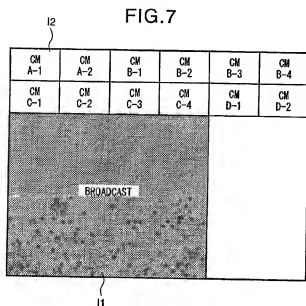
Claim 32 is representative and recites, *inter alia*:

"... said information related to each of a plurality of broadcast commercial portions being one selected from the group consisting of (a still image, text, and graphic) displayed together in a line at an upper portion of the display according to the sequence of reproduction"

When the recorded broadcast portions are reproduced, also reproduced together with broadcast portions is information corresponding to the broadcast commercial portions of the

broadcast, for example, still images of the header portions of the broadcast commercial portions or text, graphics, etc. indicating information relating to the broadcast commercial portions.

This information (e.g., a still image) about the commercials is all displayed in a line at an upper portion of the display that is also displaying the broadcast program below. Moreover, the information corresponding to the broadcast commercial portions are displayed according to the sequence of reproduction of the broadcast commercial portions. This is illustrated in FIG. 7 of the as-filed specification.



Note, the broadcast commercial portions are arrayed at the top of the display in the sequence received in the broadcast program information. Publ. App. par. [0096]-[0097] and FIG 7.

Claim 32 also recites, *inter alia*:

“wherein a commercial broadcast information is reproduced in any desired order by selection from the information displayed in a line at the upper portion of the display.”

That is, the information corresponding to the broadcast commercial portions are displayed in the line on the display screen as in FIG. 7. A particular broadcast commercial portion is selected for viewing by an instruction from the user. When a commercial broadcast is designated for viewing, the broadcast being reproduced is interrupted and the designated broadcast commercial portion is reproduced. Publ. App. par. [0098]-[0102]

The Office Action, par. 8 at page 17, points to Baji col. 3, line 58 –col. 4, line 13, and col. 8, lines 9-10 for the above recited elements of claim 32. However, at the cited location, or anywhere else in Baji, Baji fails to disclose the above recited elements of claim 32 because: **Baji does not describe (1) culling information which is a still image, text, or graphic for each of the broadcast commercials, (2) presenting those information in a line at an upper part of the display while the broadcast program is being reproduced on the display below, and (3) enabling the viewer to select a particular commercial from the displayed listing.**

Indeed, at most (which is not conceded) Baji at col. 3, line 58 –col. 4, line 13 is describing a broadcaster inserting commercials into a broadcast program in various orders. And at col. 8, lines 9-10, Baji is merely stating commercial insertion can be done by the receiver of the broadcast. However, Baji is not describing the selection technique recited in claim 32. That is, there is no suggestion a still image, text, or graphic related to the commercial is displayed in a line at the upper part of the display while the broadcast program is being reproduced. Moreover, there is not suggestion in Baji the viewer selects a particular commercial from the line of displayed commercial information at the upper part of the display.

Claim 32 is believed patentable over the cited references because those references taken alone or in combination do not disclose or render predictable each and every element recited in the claim.

Independent claims 8, 17, and 23 are believed patentable for substantially the same reasons as claim 8.

B. Dependent Claims 33-36

The Office Action, at page 11, rejected claims 33-36, asserting Official Notice. Applicant respectfully challenges the assertion of Official Notice.

Assertions Not Properly Officially Noticed or Not
Properly Based Upon Common Knowledge

Claim 36 is representative and recites:

“wherein the information related to a selected one of the plurality of broadcast commercial portions is erased from the line at the upper portion of the display device after the reproduction of the selected broadcast commercial portion.”

That is, claim 36 adds the feature that the information related to the broadcast commercial portions that are displayed in a line at the top of the display device are erased from the display device after the reproduction of the corresponding broadcast commercial portion.

That is, the commercial information being a still image, text, or graphic representing the commercial is displayed in a line at the upper part of the display. As each commercial is selected by the user and reproduced, the still image, text, or graphic representing that commercial is erased from the display.

The present Office Action relies on Official Notice in order to reject claim 36.

Applicants respectfully traverse this rejection.

From the MPEP 2144.03(E): “Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. *See, for example, In re Zurko*, 258 F.3d 1379, 1386; *In re Ahlert*, 424 F.2d 1088, 1092.”

Further, “[a]s noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).” MPEP 2144.03 (emphasis added).

The Office Action at page 11, cites no additional reference and states “Official Notice is taken that it is well known that once a commercial is reproduced it is replaced by another one on the screen.”

First, this is an incorrect statement of the claimed element. The claimed element does not “replace” one commercial with another. The claimed element is, “the information related to a selected one of the plurality of commercial broadcast information is erased” from the line at the upper part of the display.

Second, Applicant is using a technique in a particular application to achieve a specific purpose. The Office Action ignores the context of the elements. The invention as claimed in claim 36 claims information related to each of a series of commercials is displayed in a line at the upper part of a display. The information is a still image, graphic, or text related to the commercial. As each commercial is selected from the line for reproduction, the related information is erased from the line after the commercial is reproduced.

Applicant is **not** claiming “replacing” one commercial with another, asserted on the Office Action. The Office Action cannot remove the element from the claim as a whole in order to defeat patentability.

Applicant contends the Office Action depends on a mere conclusory statement and an impermissible reliance on Official Notice. Applicant contends when, as described in the claim 36, the still image, graphic, or text to each commercial is displayed in a line at the upper part of the display while the broadcast program is reproduced below. After a user selects a particular commercial from the line of related information, that information is erased from the display.

The particular technique recited in claim 36 is not of notorious character nor insubstantial, as asserted in the Office Action. Certainly, that feature is not capable of “**instant and unquestionable demonstration as to defy dispute**.” These features are neither “basic knowledge” nor “common sense.” In re Lee, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (“Deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’”). Applicants contend that claim 36 recites substantive features that can not be overcome with Official Notice.

Thus, in accordance with MPEP 2144.03(C) and so that the record of prosecution be complete, Applicants respectfully request documentary evidence under 37 C.F.R. 104(c)(2) of the elements recited in claim 14, or an affidavit of the Examiner under 37 C.F.R. 104(d)(2) setting forth specific factual statements and explanation to support the facts asserted.

III. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Claims 2-5, 8-30, and 32-36 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: 

Paul A. Levy
Reg. No. 45,748
(212) 588-0800